

Serial No. 10/708,836  
Attorney Docket No. 60655.9900

### REMARKS

Applicants reply to the Office Action mailed on December 16, 2005, within the shortened statutory period for reply. Claims 1-47 were pending and the Examiner rejects claims 1-47. In reply, Applicants amend various claims, add claims 48-54, and address the Examiner's remarks. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

### Double Patenting

The Examiner provisionally rejects claims 1-47 over claims 1-47 of co-pending Patent Application Serial No. 10/708,835 in view of Price-Francis et al., U.S. Pat No. 5,815,252. While Applicants respectfully disagree with this double patenting rejection, in the interest of compact prosecution, Applicants submit a terminal disclaimer, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this provisional non-statutory double patenting rejection is based on the above-listed application, which is commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

### Claim Rejections

#### §112 Rejections

Claim 1-47 stand rejected under 35 U.S.C. § 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner indicates that the phrase "said system comprising" in claim 1 is confusing and unclear. Applicants amend claim 1 to clarify that "said system" refers only to the transponder-reader system.

Regarding the phrase "a device configured to verify said proffered retinal scan sample to facilitate a transaction" in claim 1, Applicants submit that such phrase is sufficiently definite and supported in, for example, paragraph [00223] of the specification:

[00223] For example, for retinal scans, protocol/sequence controller 208 may utilize an existing database to compare the blood vessel patterns of the retina by comparing stored and detected retinal patterns.

Serial No. 10/708,836  
Attorney Docket No. 60655.9900

Regarding the phrase "finite number" in claim 3, Applicants amend claim 3 to clarify that the detecting may include "receiving a limited number" of biometric samples.

Regarding the phrase "remote database" in claim 7, Applicants amend claim seven to ensure proper antecedent basis.

Regarding the phrase "authorized sample receiver" in claim 7, Applicants submit that such phrase is definite and support by the specification in, for example, paragraph [00151]:

[00151] The biometric system may be configured as a security system and may include a registration procedure in which a user of transaction instrument (e.g., fob 102) proffers a . . . biometric sample to an authorized sample receiver (ASR). An ASR may include a local database, a remote database, a portable storage device, a host system, an issuer system, a merchant system, a fob issuer system, an employer, a financial institution, a non-financial institution, a loyalty point provider, a company, the military, the government, a school, a travel entity, a transportation authority, a security company, and/or any other system or entity that is authorized to receive and store biometric samples and associate the samples with specific biometric databases and/or transaction instruments (e.g., fobs 102).

Regarding claim 17, the terms "primarily," "secondarily," "first user information" and "second user information" are defined and examples thereof provided in the specification in, for example, paragraphs [00155]-[00158]. The first and second user information may be separate accounts of an individual user or may be separate accounts of separate users.

For example, paragraph [00156] discloses:

The fob user information may also contain information about the user including personal information--such as name, address, and contact details; financial information--such as one or more financial accounts associated with the fob user; loyalty point information--such as one or more loyalty point accounts (e.g., airline miles, charge card loyalty points, frequent diner points) associated with the fob user; and/or non-financial information--such as employee information, employer information, medical information, family information, and/or other information that may be used in accordance with a fob user.

Similarly, paragraph [00156] discloses:

By "primarily" associating a sample with an account, the system initially associates the sample with that account. For example, fob user submitting his right index fingerprint for a financial transaction may have money for the transaction taken from his credit card account. Fob user may additionally specify which accounts should be secondarily associated with a sample.

Serial No. 10/708,836  
Attorney Docket No. 60655.9900

Regarding use of the phrase "mutual authentication" in claim 18, the specification discloses at, for example, paragraph [0022] that:

In one exemplary embodiment, as a part of the identification process, the fob and the RFID reader may engage in mutual authentication. The RFID reader may identify the fob as including an authorized system transponder for receiving encrypted information and storing the information on the fob memory. Similarly, the fob, upon interrogation by the RFID reader, may identify the RFID reader as authorized to receive the encrypted and stored information. Where the RFID reader and the fob successfully mutually authenticate, the fob may transmit to the RFID reader certain information identifying the transaction account or accounts to which the fob is associated.

Applicants amend claim 22 to clarify that the device "is configured to facilitate the use of at least a secondary security procedure." The specification discloses at, for example, paragraph [00168], secondary security procedure examples:

[00168] Fob 102 may additionally be configured with secondary security procedures to confirm that fake biometric samples are not being used. For example, to detect the use of fake fingers, fob 102 may be further configured to measure blood flow, to check for correctly aligned ridges at the edges of the fingers, and/or any other secondary procedure to reduce biometric security fraud. Other security procedures for ensuring the authenticity of biometric samples may include monitoring pupil dilation for retinal and/or iris scans, pressure sensors, blinking sensors, human motion sensors, body heat sensors and/or any other procedures known in the art for authenticating the authenticity of biometric samples.

Applicants amend claims 23 and 35 to clarify that it is a "retinal scan sample" (emphasis added) that is proffered to a biometric sensor, rendering moot the rejection of claims 23 and 35 and those claims that depend therefrom.

Accordingly, Applicants request withdrawal of the rejection of claims 1-47 under 35 U.S.C. § 112.

### §103(a) Rejections

Claims 1-7, 12-25, 27-30, 33-41 and 43-47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kita, U.S. 6,703,918 ("Kita") in view of Price-Francis, U.S. 5,815,252 ("Price-Francis"). Claims 8-10, 26 and 31 stand rejected over Kita in view of Price-Francis as applied to Claims 1, 23 and 29, and in further view of Murakami, et al., U.S. 6,483,929 ("Murakami"). Claims 11, 32 and 42 stand rejected over Kita in view of Price-Francis as applied

Serial No. 10/708,836  
Attorney Docket No. 60855.9900

to Claims 1, 23 and 35, and in further view of Stark, U.S. 6,116,736 ("Stark"). Applicants respectfully traverse.

While Kita may generally disclose use of biometric security measures with portable information devices, and Glass, Price-Francis, Murakami and Stark disclose various biometric recognition technologies, neither Kita, Glass, Price-Francis, Murakami and Stark, nor any combination thereof, teaches or suggests at least a device "configured to determine whether said transaction is in compliance with a preset transaction limitation associated with said retinal scan sample," as recited in independent claim 1. As requested by the Examiner, support for this amendment is found in the specification in, for example, paragraphs [00235]-[00238].

Accordingly, Applicants assert that claim 1 is patentable over the cited references. Claims 2-22 variously depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 2-22 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features.

Similarly, neither Kita, Glass, Price-Francis, Murakami and Stark, nor any combination thereof, teaches or suggests a method comprising at least "determining whether said retinal scan sample is associated with a preset transaction limitation," as recited in independent claim 23. As requested by the Examiner, support for this amendment is found in the specification in, for example, paragraphs [00235]-[00238]. Accordingly, Applicants assert that claim 23 is patentable over the cited references. Claims 24-34 variously depend from claim 23 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 24-34 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features.

Similarly, neither Kita, Glass, Price-Francis, Murakami and Stark, nor any combination thereof, teaches or suggests a method comprising at least "authorizing a transaction to proceed upon verification that said transaction is in compliance with a preset transaction limitation associated with said proffered retinal scan sample," as recited in independent claim 35. As requested by the Examiner, support for this amendment is found in the specification in at least paragraphs [00235]-[00238]. Accordingly, Applicants assert that claim 35 is patentable over the cited references. Claims 36-47 variously depend from claim 35 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 36-47 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own

Serial No. 10/708,836  
Attorney Docket No. 60855.9900

respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-47 under section 103.

**New Claims**

New claims 48-54 variously depend from claims 1, 23, and 35 and contain all of the respective elements thereof. Therefore, Applicants assert that new claims 48-54 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features.

**CONCLUSION**

Applicants respectfully submit that the pending claims (54 total, 3 independent) are in condition for allowance. No new matter is added in this Reply. Reconsideration of the application is thus requested. The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

Dated: 3-14-06

By: Kirk Dorius

Kirk Dorius  
Reg. No. 54,073

**SNELL & WILMER L.L.P.**  
400 E. Van Buren  
One Arizona Center  
Phoenix, Arizona 85004  
Phone: 602-382-6544  
Fax: 602-382-6070  
Email: [kdorius@swlaw.com](mailto:kdorius@swlaw.com)